

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Chih C Tsien et al.	Examiner:	Allahyar Kasraian
Serial No.:	10/615,471	Group Art Unit:	2617
Filed:	July 7, 2003	Docket:	884.F42US1
Title:	UNIFORM CHANNEL SPREADING IN A WIRELESS LOCAL AREA NETWORK USING DYNAMIC FREQUENCY SELECTION		

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Commissioner for Patents
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Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated below.

Applicants respectfully submit that the final Office Action has improperly relied on hindsight reconstruction in modifying references to reject the pending claims. Applicants previously cited *Graham v. John Deere*,¹ *KSR Int'l. v. Teleflex Inc.*,² and *In re Warner*³ in the response filed on July 10, 2008. In addition to those cases, Applicants note that the CCPA in *In re Spinnoble* stated that "[t]he court must be ever alert not to read obviousness into an invention on the basis of the applicant's own statements; that is, we must view the prior art without reading into that art appellant's teachings."⁴ Subsequent to KSR, *In re Spinnoble* remains good law for the proposition noted.

Koohgoli and Frixon

Claims 1 and 3-5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Koohgoli et al. (U.S. Patent 5,276,908, Koohgoli) in view of Frixon (U.S. Patent No. 5,138,456). Applicants respectfully traverse.

Koohgoli relates to dynamic channel allocation and mentions scanning available traffic channels in a wireless communication system with base stations and subscriber terminals. Frixon

¹ *Graham v. John Deere Co.*, 148 USPQ 459 (1966).

² *KSR Int'l. v. Teleflex Inc.*, 82 USPQ2d 1385 (2007).

³ *In re Warner*, 154 USPQ 173 (CCPA 1967).

⁴ *In re Spinnoble*, 160 USPQ 237, 243 (CCPA 1969).

describes a camera that scans the range of frequencies between 400 and 800 MHz and then selects a free channel on which to transmit to a television. The frequency selected is displayed on a display device and a user must adjust a television set to pick up transmissions from the camera. Frixon depends on a human user to tune a television to a frequency selected as a result of a scan. Frixon is very different from Koohgoli, so different that it is non-analogous art. One skilled in the art using common sense would not have looked to Frixon to modify Koohgoli. The final Office Action cited *In re Oetiker*⁵ in response to Applicant's remarks. The Federal Circuit said in *Oetiker*:

[I]t is necessary to consider...common sense – in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor...The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness.⁶

In addition, Koohgoli teaches away from the combination proposed in the final Office Action. As discussed in the response filed on July 10, 2008, in Koohgoli it is necessary that the base station supply the subscriber terminal with a list of available channels. In contrast, only the camera in Frixon carries out a scan and selects an emission frequency. The television plays no role in selecting the emission frequency in Frixon. One skilled in the art using common sense would not have looked to Frixon to modify Koohgoli because the activity all takes place in the camera, and the selection of the emission frequency is not the result of an interaction between two devices.

Applicants respectfully submit that the final Office Action has improperly relied on hindsight reconstruction by using knowledge gleaned only from Applicant's disclosure in modifying Koohgoli in view of Frixon.

Choi and Frixon

Claims 7 and 9-11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Choi et al. (U.S. 7,206,840 B2) in view of Frixon. Applicants respectfully traverse.

Choi relates to dynamic frequency selection and describes "monitoring of channels"

⁵ *In re Oetiker*, 24 USPQ2d 1443 (Fed. Cir. 1992).

⁶ *In re Oetiker*, 24 USPQ2d at 1446.

which includes “(1) channel measurement by AP; (2) request for channel measurement by AP; and, (3) measurement report by STAs.”⁷ Choi describes channel measurements by both the AP and the STAs. The AP then “determines a new channel that is used for communication between the AP and the STAs.”⁸

Frixon, discussed above, is very different from Choi, so different that it is non-analogous art. One skilled in the art using common sense would not have looked to Frixon to modify Choi.

In addition, Choi teaches away from the combination proposed in the final Office Action. Choi describes that both the AP and the STAs make channel measurements. In contrast, only the camera in Frixon carries out a scan and selects an emission frequency. The television plays no role in selecting the emission frequency in Frixon. One skilled in the art using common sense would not have looked to Frixon to modify Choi because the activity all takes place in the camera, and the selection of the emission frequency is not the result of an interaction between two devices.

Applicants respectfully submit that the final Office Action has improperly relied on hindsight reconstruction by using knowledge gleaned only from Applicant’s disclosure in modifying Choi in view of Frixon.

Lopez

Claims 6 and 12 were rejected in view of Lopez (U.S. Patent No. 7,177,291 B1) combined with Choi or Koohgoli. Applicants respectfully traverse.

Lopez discusses two local networks N1 and N2 and a new mobile terminal MT5 that is to be integrated into an existing network. If MT5 attempts to communicate with N1 and there is a collision with traffic from N2, MT5 requests a new frequency from N1. MT5 may suggest a channel to N1 after monitoring various channels, but N1 selects a new frequency based on a criteria not described in Lopez. The monitoring of channels by MT5 does not directly lead to a selection of a new channel, and in fact the new channel selection is not described as a result of a scan of available frequencies.

The final Office Action has not shown Lopez to be compatible with Choi which describes

⁷ Choi, column 4, lines 20-23.

⁸ Choi, column 7, lines 63-65.

channel measurements by both an AP and STAs. The final Office Action has not shown Lopez to be compatible with Koohgoli in which the base station scans available traffic channels, and sends a “subscriber terminal a list of available traffic channels upon which a call would be acceptable.” The subscriber terminal of Koohgoli scans the channels on the list, and then prioritizes its preferences for the base station. Lopez is very different from both Choi and Koohgoli, and one skilled in the art would not have been motivated to modify Choi or Koohgoli in view of Lopez.

In re Keller

The final Office Action cited *In re Keller* and *In re Merck & Co.* for the statement in *In re Keller* that “one cannot show non-obviousness by attacking references individually.”⁹ Applicants have argued that Frixon, Choi, Koohgoli, and Lopez are non-analogous art, and that Koohgoli and Choi teach away from the combinations.

Design Choice

Claims 4, 5, 10, 11, 13, 16, 17 and 20 were rejected based on “design choice.” Applicants respectfully traverse.

The final Office Action did not cite any references showing the features such as “selecting a larger gap at a higher frequency” recited in claims 4, 5, 10, 11, 13, 16, 17 and 20. The final Office Action indicates that these features were a matter of “design choice.” *In re Warner* indicates that “[a] rejection based on section 103 clearly must rest on a factual basis.” The rejection of the features of claims 4, 5, 10, 11, 13, 16, 17 and 20 is not founded on a factual basis such as a reference, but rather is supported only by speculation called “design choice” contrary to *In re Warner*. Applicants respectfully request that these rejections be withdrawn.

In re McLaughlin

The final Office Action cited *In re McLaughlin* in several locations for the statement that “[a]ny judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but so long as it ... does not include knowledge gleaned only from applicant’s

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disclosure, such a reconstruction is proper."¹⁰ Applicants respectfully submit that the final Office Action has improperly relied on hindsight reconstruction by using knowledge gleaned only from Applicant's disclosure in modifying the applied references.

Conclusion

The final Office Action has not identified a factual basis or a rational underpinning that supports these combinations of references, and has instead relied on hindsight reconstruction to reject claims 1, 3-7, 9-13, 16, 17, and 20. Applicants respectfully submit that a *prima facie* case of obviousness of claims 1, 3-7, 9-13, 16, 17, and 20 has not been established in the final Office Action, and that claims 1, 3-7, 9-13, 16, 17, and 20 are in condition for allowance.

Applicants respectfully submit that all of the pending claims are in condition for allowance, and such action is earnestly solicited. The Examiner is invited to telephone the below-signed attorney at (612) 373-6973 to discuss any questions which may remain with respect to the present application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,
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Date 27 February 2009 By _____

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 27th day of February 2009.

Name

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Signature

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⁹ *In re Keller*, 208 USPQ 871, 882 (CCPA 1981).

¹⁰ *In re McLaughlin*, 170 USPQ 209, 212 (CCPA 1971).